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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,031	02/12/2002	Sidney F. Hauschild	AMS-057	7514

7590

01/30/2004

AMS Research Corporation on behalf of
American Medical Systems
10700 Bren Road West
Minnetonka, MN 55343

EXAMINER

PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 01/30/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,031

Applicant(s)

HAUSCHILD ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 4-7, 11 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of 12/15/2003 in Paper No. 7 is acknowledged.

Applicant has traversed both the Restriction between inventions I and II and the election of species.

Concerning the traversal of the Restriction Requirement, the traversal is on the ground(s) that "The restriction requirement will require applicants to file at least one additional application in order to have all claims considered. This will require additional filing, prosecution and maintenance fees should the additional application(s) be granted. This represents a substantial burden to the owners of the present application. Applicants submit that the public would be better served if the restriction and election of species requirements were withdrawn, as the cost of seeking patent protection would be less, at least for applicant." This is not found persuasive because in order for a restriction between two or more inventions to be proper, two criteria must be met:

- a) the inventions must be independent or distinct and
- b) searching and examiner all the inventions cannot be made without serious burden on the Examiner.

The Examiner set forth reasons why each of these criteria is true in the Restriction Requirement mailed 12/02/2003. It should be noted that just because searches for independent or distinct inventions may overlap, searching both may still be a serious burden on the Examiner as searching for independent or distinct inventions

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requires different search strategies and/or different search techniques and/or different modes of thought.

Concerning the traversal of the Election of Species, the Examiner agrees with Applicant that an election of species was not required for Group I.

The requirement is still deemed proper and is therefore made FINAL.

Claims 15-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objections

Claim 1 is objected to because of the following informalities: in line 15, "a foreign body" should be --said foreign body--. Appropriate correction is required.

Claim 6 is objected to because of the following informalities: in line 2 of claim 6, "the foreign body capturing assembly" should be changed to --said plurality of tines--. Appropriate correction is required.

Claim 11 is objected to because of the following informalities: in line 2, "change" should be --chance--. Appropriate correction is required.

Claim 13 is objected to because of the following informalities: in line 7, "the finger member" should be --the finger ring--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 10 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10 and 14 recite the limitation "the body" in lines 10-11 and 7 respectively. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 8, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakao et al. (U.S. 5,156,609) in view of Gauderer et al. (U.S. 6,361,540) with reference to Exhibit A. Nakao et al. teaches an apparatus capable of retrieving a foreign body comprising: an axially elongate member 88 having a foreign body capturing assembly 91, the elongate member 88 having an inner lumen that is sized and shaped to receive a viewing apparatus; a substantially tubular member 82 having a distal end and an inner lumen that is sized and shaped to receive the elongate member 88; the elongate member 88 and tubular member 82 being operatively associated to move between an open position with the foreign body capturing assembly 91 adapted to receive a foreign body, and a closed position with the foreign body

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capturing assembly 91 adapted to control said foreign body, and a cylindrical sheath 86 having an outer diameter, a length and an inner lumen 84 that is sized and shaped to afford sliding passage of the tubular member 82 and the elongate member 88 while in the closed position; wherein the foreign body capturing assembly 91 comprises a plurality of tines 91a & 91b, each tine 91a/b having an inclined portion IP and a foreign body engagement portion EP, each tine 91a/b being constructed to be resiliently biased toward the open position, and the tubular member 82 being arranged so that movement toward the closed position causes the distal end of the tubular member 82 to engage the inclined portions IP of the tines 91a/b to cam the tines 91a/b toward the closed position; wherein the sheath 86 is substantially cylindrical with an outer diameter and the lumen 84 of the sheath 86 is constructed to afford rotation of the elongate member 88 and tubular member 82 about the elongate axis of the elongate member 88; wherein the tines 91a/b are each constructed to be resiliently biased toward the open position, and the tubular member 82 being arranged so that movement toward the closed position causes the distal end of the tubular member 82 to engage the inclined portion IP of the tines 91a/b to cam the tines 91a/b toward the closed position, and in the open position, at least a portion of the tines 91a/b and the foreign body engagement portions EP project radially beyond the outer diameter of the sheath 86.

Hence Nakao et al. teaches all of the limitations of the present invention except a handle comprising a thumb ring and a finger ring movable between adjacent and remote positions, the thumb ring assembled to be substantially stationary relative to the axially elongate member, the finger ring being operatively associated with the tubular member

so that movement of the finger ring relative to the thumb ring from the remote toward the adjacent position moves the tubular member distally in a direction substantially parallel to the axis of the elongate member.

Gauderer et al. teaches an apparatus comprising a handle 16 & 14 comprising a thumb ring 16 and a finger ring 14 movable between adjacent and remote positions, the thumb ring 16 assembled to be substantially stationary relative to an axially elongate member 20, the finger ring 14 being operatively associated with a tubular member 30 so that movement of the finger ring 14 relative to the thumb ring 16 from the remote toward the adjacent position moves the tubular member 30 distally in a direction substantially parallel to the axis of the elongate member 20. The thumb and finger ring configuration facilitates the reversible opening and closing of jaws 12 (lines 15-16 of column 3). It would have been obvious to one of ordinary skill in the art at the time of the present invention to use a handle system like that of Gauderer et al. with the apparatus of Nakao et al. to facilitate reversible opening of tines 54a and 54b of Nakao et al.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Nakao et al. as modified by Gauderer et al. as applied to claim 1 above, and further in view of the following. The combination of Nakao et al. and Gauderer et al. discloses the claimed invention except for that the outer diameter and length of the sheath are sized and shaped to afford transurethral passage of the sheath from the external meatus of the urethra to the bladder of a male patient. It would have been an obvious matter of design choice to construct the apparatus of the combination of Nakao et al. and Gauderer et al. of a size to afford transurethral passage of the sheath from the

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external meatus of the urethra to the bladder of a male patient, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Allowable Subject Matter

Claims 4, 5, 7 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 6 and 11 would be allowable if rewritten to overcome the objection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 10 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

Michael B. Priddy
January 22, 2004

FIG-8A

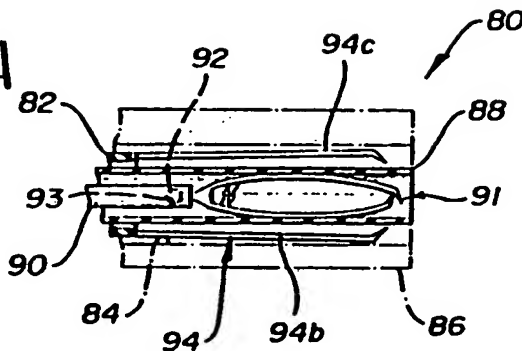


FIG-8B

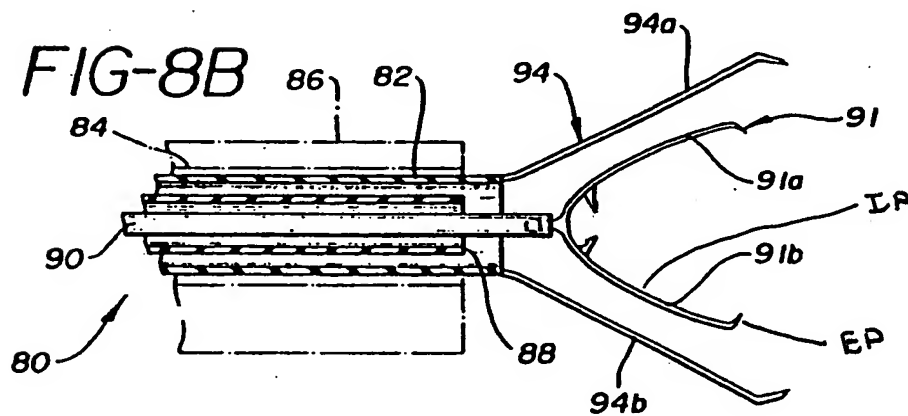


FIG-8C

